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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,436	02/25/2004	Henry J. McVicker	513779600009	4874
28104	7590	11/18/2005	EXAMINER	
JONES DAY			HECKENBERG JR, DONALD H	
77 WEST WACKER			ART UNIT	
CHICAGO, IL 60601-1692			PAPER NUMBER	

1722

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/786,436	Applicant(s) MCVICKER ET AL.	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Korsch (U.S. Pat. No. 3,784,344; previously of record).

Initially it is noted that several of the claims of the instant application recite "means for" clauses. These elements have been interpreted as invoking 35 U.S.C. § 112, sixth paragraph, and thereby are limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1950 (Fed. Cir. 1994); MPEP § 2181. Specifically, claims 11 and 14 recite that the mold comprises "means...for mounting" the insert. The specification of the instant application discloses a means for mounting as the projections described at ¶ 18, or the retaining surfaces described at ¶ 20.

Korsch discloses a molding apparatus for manufacturing a molded article. The apparatus includes an insert (4) being sized and dimensioned to fit within a recess in the mold (see

Figs. 1 and 2). The insert includes a first surface having an area (5) thereon that is a complement of the structural feature to be imparted on the molded article. A means for mounting the insert in recess on the inner surface of the mold is provided. Specifically, the means for mounting includes projections (6) which fit within depressions in the inner surface of the mold cavity (see Fig. 1). The projections comprise apertures for receiving screw fasteners (8) such that the screws are recessed with respect to a front surface of the projections when the insert is placed on the inner surface of the mold (see Fig. 2).

3. Claims 14, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chittenden et al. (U.S. Pat. No. 3,380,121; previously of record).

Chittenden discloses a mold with replaceable inserts. As shown in Fig. 2, the mold has an inner surface defining a cavity (14) in which a molded article is formed. The inner surface has a recess adapted for receiving a mold insert (16). The mold insert is sized and dimensioned to fit within the recess, and includes a first surface for forming the structural feature on the surface of the molded article (see Figs. 1 and 2).

Chittenden further discloses the mold insert (16) to include a means for mounting in the recess on the inner surface

(14) of the mold (see Fig. 2). The means for mounting comprises retaining surfaces and a retaining means (22 and 23) that engages the retaining surfaces (see Fig. 2). More specifically, the retaining surface comprise a shoulder extending from the side of the mold insert, and the retaining means comprises retaining blocks (22 and 23) having surfaces that engages the shoulder (see Fig. 2). The retaining blocks (22) include apertures for receiving a fastening means (24).

4. Applicant's arguments filed 16 September 2005 with respect to claims 11 and 13-18 have been fully considered but they are not persuasive.

Applicant asserts that the structure of the claimed is different from Chittenden and Korsch in that the recited mold insert is mounted directly to the inner surface of the mold cavity that defines the mold article. Applicant's argument seems to imply that the mold cavity as used in the claims cannot include surfaces other than those in which the molded article is formed, and that Chittenden and Korsch disclose the inserts as attached to portions of the mold other a mold cavity portion which molds the formed article.

This argument is not commensurate with the scope of the claim language. While the claims define the "inner surface as

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having a cavity in which the molded article is formed" (claim 14, lines 2 and 3), nothing in the claims excludes the mold cavity as including other portions. That is, the mold cavity could include a portion forming the molded article (as claimed), and other portions not forming the molded article. Note the claims are in open-ended format, thereby not excluding additional unrecited elements. MPEP § 2111.03.

As described above, both Korsch and Chittenden disclose molding apparatus that include mold cavities, with inserts being mounted to the inner surfaces of these mold cavities. Korsch and Chittenden therefore anticipate the claims.

5. Claims 1-10 and 22-25 are allowed.

6. Claims 19-21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to teach or suggest an insert as recited in claim 1 of the instant application. The closest

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prior art disclosed by Korsch and Chittenden is described above. Neither Korsch nor Chittenden disclose the insert to include a surface with an area that is a complement to a field of integrally molded hooks on the molded article. Note this the language of being "complement" to a field of integrally molded hooks on the molded article has been taken to mean that the insert must have a surface with an area that that is a corresponding shape to the hooks. Note as well the means plus function elements in claim 1 have been interpreted as described in the previous Office Action.

See also the previous Office Action a statement of reasons why other subject matter is indicated allowable over the prior art of record.

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

 11-15-5
Donald Heckenberg
Primary Examiner
A.U. 1722